

REMARKS

The Applicants respectfully request reconsideration and allowance of claims 1-18 and 20-24 in view of the above amendments and the following arguments.

I. THE AMENDMENTS

Claim 3 is amended to clarify the definition of a claim term, no change of scope is intended and no new matter has been added.

II. THE CLAIMS ARE NOT OBVIOUS IN VIEW OF THE CITED ART

The Office Action rejected claims 1-7, 18, 20-22, and 24 under U.S.C. §103(a) as being unpatentable over U.S Patent Application Publication No. 2003/0003980 to Moody (the “Moody reference”). The Applicants respectfully traverse the rejection below.

Claims 1, 18, and 20

In the current Office Action, the Examiner rejects claims 1, 18, and 20 as obvious over a single prior art reference, the Moody reference. The Office Action admits that the Moody reference teaches a base game and bonus game whose outcomes are determined by two independent random events, and fails to find proper basis in the prior art for the rejection.

The Office Action provides two potential rationales as to why one of ordinary skill in the art would change the device in Moody to achieve the claimed invention. This portion of the rejection is reproduced below in order to respond to each of the points in turn:

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the device of Moody such that the outcome of the base game and bonus game are determined by the same random selection in order to reduce processing overhead needed to operate each game. As further motivation to modify Moody, one of ordinary skill in the art would have recognized that the overall outcome of a game of Moody (i.e., base game winnings plus bonus game winnings) may be advantageously controlled by selecting both outcomes at the same time in order to ensure that the target payout percentage of the game is maintained. In other words, one of ordinary skill in the art would recognize that outcomes of the base and bonus game could be simultaneously chosen such that the overall winnings never exceed a predetermined limit in a single round of the game, which is an advantage because gaming operators would limit the liability of paying out large prize values.

(Office Action at page 4.) The Applicants respectfully traverse this rejection on the basis that 1) the prior art does not contain all the claimed limitations, and 2) the reasons provided to modify the art are inadequate because they also do not provide a specific motivation to modify the art as suggested.

For, regarding the “reasons to modify” cited in the Office Action, it should be pointed out that language of the rejection does not address all the claimed limitations. The rejection says it would be obvious to modify the Moody device to make “the outcome of the base game and bonus game” determined “by the same random selection....” However, this language from the rejection is not actually present in the claim, and does not by itself teach the claimed game play result “specifying a prize value” for the bonus round.

Further, the Applicants traverse the rejection as improperly officially noticed because it relies on only one prior art reference with the admittedly missing element being produced out of

1 thin air on the basis that the modification would be “obvious.” The rejection does not contain  
2 any factual findings that such a technique is well known in the art, and does not take official  
3 notice of facts that are obviously not taught in any cited prior art. The specific reasoning of each  
4 traversal is discussed below.

5 The first reason given in the Office Action to produce a single outcome used for the base  
6 and bonus rounds is “in order to reduce processing overhead needed to operate each game.”  
7 (Office Action at page 4, quoted above.) The Applicants respectfully submit that this reason is  
8 not enough to establish a prima facie case because it suggests nothing about the actual claimed  
9 limitations. This is a classic case of “hindsight” obviousness rejection. That is, there is  
10 absolutely nothing in the art or the reason provided (“to reduce processing overhead”) that  
11 suggests the claimed elements in any way. While it is true, in some cases, implementing the  
12 claimed invention may help reduce game-time processing overhead by, for example, shifting it to  
13 an earlier pre-play result generation stage, such modifications are merely an advantage  
14 recognizable after knowledge of the claimed invention. *The suggested modifications to not*  
15 *follow from any cited prior art teaching, which makes them a classic case of impermissible*  
16 *hindsight.* The Office Action did not attempt to cite any prior art or common knowledge  
17 teaching or suggesting that the claimed features are a well-known solution to any problem found  
18 in the Moody reference. In fact, the Office Action did not even try to establish that processing  
19 overhead would be a problem in the Moody game, or to establish that the claimed features are a  
20 well-known solution to that particular problem. The Applicants submit that there is no  
21 indication in Moody that processing overhead regarding the bonus prize is a problem. Indeed,

1 simple reasoning shows exactly the opposite: the bonus game presents choices to the player, and  
2 subsequently waits for player input, and therefore has plenty of time to generate the appropriate  
3 outcome (which is, by the way, a negligible processing load compared with all of the graphics  
4 functions needed to make the bonus game display). One of ordinary skill would therefore not be  
5 motivated to find processing load reduction techniques with regard to the outcome generation.  
6 The Applicants therefore respectfully traverse this rejection as lacking adequate basis to  
7 establish a prima facie case of obviousness.

8         Next, the rejection indicates that another reason (apparently, a second reason) to modify  
9 the Moody reference to produce the missing elements would be that “to ensure that the target  
10 payout percentage of the game is maintained” or, in other words, to ensure that “the overall  
11 winnings never exceed a predetermined limit in a single round.” (Office Action at page 4,  
12 quoted above.) This rejection is also traversed as improperly officially noticed because it relies  
13 on only one prior art reference because it also is not based on any cited material. The rejection  
14 does not even assert that the technique would be a well-known solution to any problem found in  
15 the Moody reference. The source of the technique is not cited at all. The rejection does not  
16 contain any factual findings that such a technique is well known in the art, and does not take  
17 official notice of facts that are obviously not taught in any cited prior art.

18         Further, regarding the rejection’s cited reason that the Moody reference would be  
19 modified, this reason, again, is to ensure that “the overall winnings never exceed a  
20 predetermined limit in a single round.” (Office Action at 4.) First of all, any bonus game that is  
21 payable driven (i.e., almost every bonus game in the entire slot machine industry, except

1 progressive games) will have this characteristic, whether the bonus outcome is made at the same  
2 time as the base outcome or not. In the case where the bonus outcome is not made at the same  
3 time (and also does not consider the base game outcome in determining the prize), the  
4 “predetermined limit” is the sum of the base game highest award and the bonus game highest  
5 award. Why would one of skill change Moody to provide a feature that is already there? Next,  
6 even if there were some prior art technique with a known advantage of *improving* the  
7 predetermined limit (remember nothing is needed to *provide* such a limit), there is no suggestion  
8 in Moody that such improvement is needed, or that limitations on the awards in a single game  
9 round are a problem in Moody. There is, therefore, no apparent reason in the prior art that one  
10 would modify the Moody reference as suggested.

11  
12 Claim 3

13 Regarding claim 3, the rejection indicates that the bingo-type game mentioned in claim 3  
14 is being interpreted as “merely visual.” The rejection reads as follows:

Regarding claim 3: In applicant's remarks received by the Office on 5/25/2007,  
applicant essentially argues that the “bingo card pattern” and “bingo-type game”  
recitations do not necessarily refer to traditional bingo games wherein a player manually  
daubs the card in the spaces representing ‘called’ bingo balls (see pages 12-13). In  
view of these arguments, the Examiner will interpret the bingo-related recitations of  
claim 3 as being merely visual in the sense that the game merely looks like a bingo  
game or had some other characteristic in common with bingo games known in the art.

(Office Action at 5.) While one of ordinary skill would obviously not interpret the reel-type pattern of Moody as being a bingo-type game, the Applicants have nevertheless amended the claim to include the actual definition of the claimed bingo-type game. The material is found, for example, in the incorporated U.S. Patent 6,569,017, at column 1, lines 26-38. The Moody reference does admittedly does not teach the bingo-type game as claimed in the amended claim, and claim 3 is therefore allowable.

### III. CONCLUSION

For all of the above reasons the Applicants respectfully request reconsideration and allowance of claims 1-18 and 20-24.

If any issue remains as to the allowability of these claims, or if a conference might expedite allowance of the claims, the Examiner is asked to telephone the undersigned attorney prior to issuing a further action in this case.

Respectfully submitted,

The Culbertson Group, P.C.



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